

REMARKS

No amendments to the instant claims are presented via the current response. Claims 2, 8, 10, 15, 17, and 20 have been withdrawn from consideration. Applicants again respectfully request rejoinder of the withdrawn claims pursuant to M.P.E.P. §821.04 upon the indication of allowable subject matter. Claims 1-20 remain pending in the instant Application and are presented for the Examiner's reconsideration in light of the following comments.

Rejection Under 35 U.S.C. §103

Claims 1, 3-7, 9, 11-14, 16, and 18-19 have been rejected under 35 U.S.C. §103(a) over *McCay*, et al., U.S. Patent No. 4,506,575, in view of *Esping*, et al., U.S. Patent No. 6,761,098. Previous arguments made with regard to the *McCay* and *Esping* references remain in effect but will not be repeated for the sake of brevity. Applicants respectfully traverse this rejection and request the Examiner to consider the following additional matters that distinguish Applicants' invention as now presented over *McCay* in view of *Esping*.

The *McCay* reference goes into explicit detail to explain that a core, envisioned for use with the disclosed apparatus, is slipped on the tube 18. According to the *McCay* reference, a core having a material disposed thereabout is slid over and along the tube stem 22, thereby starting a drive unit 10 that is started and moved along a carriage 13 to the end of the core cutting the paper remaining on the core. (3:57-63) *Esping* goes into further detail to state that the core must be slipped over the tube 18 because a plurality of camshafts and cams 50, 60 must be placed in position in order to lock the core onto the tube in a fixed position. (3:40-46) The *McCay* reference goes on to state that various cam handles and camshafts are rotated in an effort to rotate a plurality of cams that lift pins positioned within openings of the tube 18. These pins lift a locking plate that engages the inner surface of the core. It is clear to Applicants representative that the *McCay* reference goes a long way to require that the cantilevered tube is indeed a necessary part of the disclosed invention. This is because it is critical that the core remain in a fixed position with respect to the drive unit and carriage of the *McCay* disclosed device. (3:51-66) This is not what Applicants claim as their invention.

In this vein, Applicants are at a loss to understand how the side supports of the *Esping* reference can be combined with the *McCay* cantilevered tube since it is clear that the side supports of *Esping* would do nothing to fix the core with respect to the carriage 13 of the *McCay* reference. Further, it is difficult to understand how the side supports disclosed by the *Esping* reference can be combined in order to position a core onto the tube 18. If the *McCay* reference requires “the core [to be] slipped onto tube 18 over the tube lock plate 17, it stands to reason that the core must be placed onto the tube 18 from one end only. It is clear from Fig. 1 of the *McCay* reference that one end of the cantilevered tube 18 is obstructed by the support 22 that suspends the tube 18. Only the end of the tube 18 that is distal from the support structure 22 suitable for the disposition of a core upon the tube. Additionally, if one were to attempt to utilize the side supports of the *Esping* reference to position a core onto the *McCay* tube 18, the core would likely catastrophically drop onto a floor or other supporting structure upon removal of one or the other side supports.

Thus, nowhere within the four corners of the *McCay* reference is there a suggestion to provide for an integral transport element capable of engaging the roll and of conveying the roll to a slabbing position where the transport element further comprises a pair of roll engaging elements capable of penetrating engagement of the core. It is unlikely that one of skill in the art having the disclosure of the *McCay* reference in hand would even be remotely likely to consider the disclosure of the *Esping* reference to modify the deficiencies provided therein without the use of impermissible hindsight. “Even if all its limitations could be found in the total set of elements combined in the prior art references, a claimed invention would not be obvious without a demonstration of the existence of a motivation to combine those references at the time of the invention.” *See National Steel Car, Ltd. v. Canadian-Pacific Railway, Ltd.*, 357 F.3d 1319, 69 U.S.P.Q.2d 1641 (Fed. Cir. 2004) The Examiner has not provided any clear or particular suggestion of combinability within the cited references that would render Applicants’ claimed invention obvious. It should be noted that the US Supreme Court has not abrogated the teaching/suggestion/motivation test but merely suggested that the teaching/suggestion/motivation test is useful as insight. *See KSR Int’l. Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007)

Thus, Applicants believe that the *McCay* reference, in view of the *Esping* reference, does not teach, disclose, or even remotely suggest each and every element of Applicants' claimed invention. In particular, the *McCay* and *Esping* references, alone or in combination, do not disclose or suggest Applicants' claimed apparatus for slabbing a roll. Accordingly, the rejection of the instant claims under 35 U.S.C. §103(a) over the *McCay* and *Esping* references should be withdrawn.

Claims 1, 3-5, 9, 11, 12, and 16 have been rejected under 35 U.S.C. §103(a) over *Pyron, et al.*, U.S. Patent No. 5,759,350 in view of *Pienta*, U.S. Patent No. 5,308,217. Additionally, Claims 1, 307, 9, 11-14, 16, and 18-19 have been rejected under 35 U.S.C. §103(a) over *Pyron* in view of *Pienta* and further in view of *McCay*. Applicants respectfully traverse these rejections and request the Examiner to consider the following matters that distinguish Applicants' invention as presented over the *Pyron*, *Pienta* and *McCay* references.

The *Pyron* reference discloses a papermaking process dry end slabbing method using high pressure fluid to remove multiple layers of unwanted paper from a spool. (Abstract) In summary, a spool 15 of unwanted paper 20 is removed from the dry end of a papermaking machine. (5:39-41) The spool 15 of unwanted paper 20 is then mounted on a pair of spaced apart rails 36. (5:41-43) As can be seen from Fig. 4, the spaced apart rails 37 engage a device that has been inserted within the spool 15 of the spool of paper 20. For this to occur, one of skill in the art would be required to presume that a bar, pipe, mandrel, tube, or other hardware must be placed within the center portion of the spool 15 in order to engage the spaced apart rails 37. The fact that additional hardware must be inserted into the spool 15 is bolstered by Fig. 2 wherein the center portion 15B is shown in cross-hatching consistent with 37 C.F.R. §1.84(h)(iii) where the line section is indicated as being solid due to the positioning of the hatching shown by regularly spaced parallel oblique strokes.

Since it is evident that the *Pyron* reference requires an insert, it is difficult for Applicants to understand how a roll chucking apparatus such as that disclosed by *Pienta* or the *McCay* apparatus reference would facilitate penetrating engagement of the *Pyron* core 15. The Examiner is respectfully reminded that the transport element of the current claims comprises a pair of roll engaging elements that are capable of penetrating

engagement of the core. If the apparatus of the *Pyron* reference requires the insertion of a bar in order to support the core upon the spaced apart rails 37, one of skill in the art would be at a complete loss to understand how any penetrating engagement of the inner portion of the core is possible by either of the *Pienta* or *McCay* devices.

Assuming, *arguendo*, that the core 15 of the *Pyron* reference having the unwanted paper 20 disposed thereon is directly positioned upon the spaced apart rails 37, then one of skill in the art is likely to understand that removal of the unwanted paper 20 would not be possible. This is because direct positioning of the spool 15 of unwanted paper 20 upon the spaced apart rails 37 would dispose a significant amount of the unwanted paper 20 between the spool and the spaced apart rails 37, thereby rendering the *Pyron* apparatus inoperable. “Even if all its limitations could be found in the total set of elements combined in the prior art references, a claimed invention would not be obvious without a determination of the existence of some motivation to combine those references at the time of the invention.” *See National Steel Car, Ltd. v. Canadian Pacific Railway, Ltd.*, 357 F.3d 1319, 69 U.S.P.Q.2d 1641 (Fed. Cir. 2004) In other words, it is difficult to see how elements that ostensibly internally engage a spool of unwanted paper, such as those envisioned by the *Pienta* or *McCay* references, could be fashioned to operate with the *Pyron* reference. In short, the Examiner has provided no clear and particular suggestion of combinability within any of the references cited that would render Applicants’ instant claims obvious.

Applicants respectfully believe that the *Pyron* reference, alone or in combination with any of the *Pienta* or *McCay* references, does not teach, disclose, or even remotely suggest each and every element of Applicants’ claimed invention. In particular, the combination of the *Pyron*, *Pienta* and *McCay* references does not teach, disclose, or even provide a modicum of a suggestion of Applicants’ claimed apparatus for slabbing a roll. Accordingly, the rejection of the instant claims under 35 U.S.C. §103(a) over the *Pyron*, *Pienta* and *McCay* references should be summarily withdrawn.

CONCLUSION

Based on the foregoing, it is respectfully submitted that each of Applicants’ remaining claims is in condition for allowance and favorable reconsideration is requested.

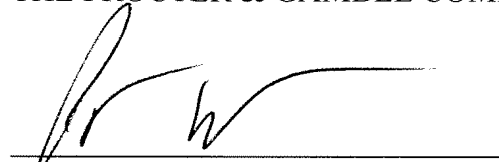
Appl. No. 10/811,160
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Customer No. 27752

This response is timely filed pursuant to the provisions of 37 C.F.R. §1.8 and M.P.E.P. §512, and no fee is believed due. However, if any additional charges are due, the Examiner is hereby authorized to deduct such charge from Deposit Account No. 16-2480 in the name of The Procter & Gamble Company.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

By:

A handwritten signature in black ink, appearing to read 'Peter D. Meyer', is written over a horizontal line.

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